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28986	7590	12/23/2010		
HARRIET M. STRIMPEL, D. Phil. New England Biolabs, Inc. 240 COUNTY ROAD IPSWICH, MA 01938-2723				
			EXAMINER	
			BERCH, MARK L	
			ART UNIT	PAPER NUMBER
			1624	
NOTIFICATION DATE	DELIVERY MODE			
12/23/2010	ELECTRONIC			

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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**DETAILED ACTION**

The amendment filed 12/02/2010 under 37 CFR 1.116 in reply to the final rejection has been considered but is not deemed to place the application in condition for allowance and will not be entered because: The proposed amendment raises new issues that would require further consideration and/or search.

Claim 1 has "acycloxy" which is unclear. Does this mean acyclic-oxy, i.e. an acyclic group is attached to the oxy, or is it acyl-oxy, i.e. an acyl group is attached to the oxy?

Also, where did this entire "optionally substituted by...." text come from? Where is the descriptive support for it?

The "including...." added to the L1 definition introduces its own problem, as it renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d). Langue of "including", "such as", "for example" and similar language has this problem.

The term "partial amino acid sequence of the HIV-tat-protein" near the end of claim 1 is indefinite and lacks description in the specification. Applicants state: "The phrase "parts of a sequence" is replaced by "a partial amino acid sequence". This interpretation is clear from the general description in paragraph [059]." Assuming that applicants intend the first full paragraph on page 15, such a phrase does not exist there, and hence lacks description in the specification. Further, it is not clear exactly what it would encompass. For example, how small could a "partial amino acid sequence" be? Is it any part of an amino acid sequence, e.g. the benzyl? If the

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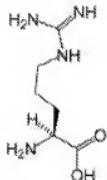
term requires multiple amino acids then of course the prior art rejections which are based on e.g. benzyl would be overcome, but it is not clear what it entails.

Claim 11 now has "a donor or an acceptor of a FRET pair." Where is such language in the specification?

There may be other problems as well.

Applicants arguments about the guanidinium group are not persuasive.

Applicants point to arginine, which in its canonical form is as follows:



That has the substituent as guanidine, not guanidinium. If the guanidine were protonated to guanidinium, there would need to be either a counterion, or the proton removed from the COOH. Molecules in reality must be neutral.

With regard to point 10, applicants point out that the term is "known in the art". It is indeed, but it doesn't have a single fixed meaning, because there are many different AGTs. The examiner has asked a specific question, and applicants have not answered it.

With regard to point 7, "active ester" is indeed in the claim. See the 6<sup>th</sup> line of the L1/L2 definition.

The remarks about Damoiseaux are not agreed with. The material qualifying as a label is attached at the 9-position, i.e. as R7, not R8. As was noted previously see e.g. compound 4. The tetrahydrofuran ring meets the definition of R2, and the

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rest certainly meets the definition of L2. For example, the CN would qualify as a spectroscopic probe using e.g. IR spectroscopy.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Mark L. Berch** whose telephone number is 571-272-0663. The examiner can normally be reached on M-F 7:15 - 3:45.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **James O. Wilson** can be reached on (571)272-0661. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

*/Mark L. Berch/  
Primary Examiner  
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12/20/2010